

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Henrik Przybilla, et al.
	:	
For	:	DIGITAL RIGHTS MANAGEMENT
	:	UNIT FOR A DIGITAL RIGHTS
	:	MANAGEMENT SYSTEM
	:	
Serial No.	:	10/577,087
	:	
Filed	:	April 24, 2006
	:	
Art Unit	:	3685
	:	
Examiner	:	James D. Nigh
	:	
Att. Docket	:	AT03 0059 US1
	:	
Confirmation No.	:	1182

REPLY BRIEF

Mail Stop Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Appellant respectfully submits this Reply Brief in response to the Examiner's

Answer mailed on March 18, 2011.

I. STATUS OF CLAIMS

Claims 8-27 are on appeal.

Claims 8-27 are pending.

Claims 1-7 are canceled.

No claims are withdrawn.

No claims are allowed.

Claims 8-27 are rejected.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

A. On pages 6 and 7, the Office Action rejects claims 10 and 21-27 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

B. On pages 7-9, the Office Action rejects claims 8, 9, and 16-20 under 35 U.S.C. § 112, second paragraph as allegedly indefinite.

C. On pages 9-15, the Office Action rejects claims 8-11, 13-16, 18-20, and 24-26 under 35 U.S.C. § 103(a) as allegedly unpatentable over Pub. No. US2004/0103312 to Messerges ("Messerges") in view of Pub. No. US2004/0117440 to Singer et al ("Singer").

D. On pages 15-18, the Office Action rejects claims 12, 17, and 21-23 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer, further in view of Pub. No. US2003/0236978 to Evans et al ("Evans").

E. On pages 18 and 19, the Office Action rejects claim 27 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer, further in view of U.S. Patent No. 5,629,980 to Stefik et al ("Stefik").

III. ARGUMENTS

In section (10) entitled "Response to Argument", starting on page 20, the Examiner's Answer puts forth several new arguments in response to Appellant's Appeal Brief. Appellant will respond to each of the Examiner's new arguments in turn.

On pages 20-21, the Examiner's Answer alleges that the authenticating step "cannot be given weight as it is not part of the claimed method." In response, Appellant respectfully submits that all words in a claim must be considered in judging the patentability of that claim against the prior art, as set forth by *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, "authenticating" is clearly recited as a step in method claim 10.

On page 21, the Examiner's Answer argues that "the disclosure is broad enough to encompass the authentication being performed by either a single device or multiple devices" and concludes that the claim fails to recite a "particular" machine. In response, Appellant respectfully submits that the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach, as set forth by *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999). In this case, at least one "particular" machine must perform the authentication step.

On page 22, the Examiner's Answer correctly concedes that the determining step recites a device. However, the Examiner's Answer then alleges that the "DRM user device is only acting as a transfer conduit." In response, Appellant respectfully submits that this interpretation of the claim language is clearly erroneous, because the

DRM user device clearly determines whether to grant permission. In particular, the DRM user device “controls the use of digital data object by the DRM client unit.” See lines 30-31 of page 7 in the specification. To implement such control, the DRM user device includes an authentication device. See line 32 of page 7 in the specification.

On page 23, the Examiner’s Answer further argues that “the majority if not the entirety of the determination is being performed by the DRM server.” In response, Appellant respectfully submits that this interpretation of the claim language is clearly erroneous, because the DRM server does not determine whether to grant permission. Words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification, as set forth by *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Here, Appellant respectfully submits that use of the DRM user device for the determining step is entirely consistent with the specification. See, for example, “The key functionality of the DRM user unit 2 is that it can grant the permission to use a specific DDO to different DRM client units 3” on lines 29-31 of page 8.

On page 24, the Examiner’s Answer alleges that a step of using the DRM server device “to update the revocation list” could be viewed a “mere insignificant data gathering step.” In response, Appellant respectfully submits that updating a list is clearly not equivalent to gathering data. In context, claim 22 recites a step of updating the list while claim 21 recites steps of storing and checking the list.

On page 26, the Examiner’s Answer alleges that the defining step of claim 27 could “simply be performed in the mind of a user or the content owner.” In response,

Appellant respectfully submits that claim 10 clearly defines digital rights objects (DROs) as representing permission to use associated digital data objects (DDOs). Consequently, the step of further defining a particular DRO as transferable cannot be a mental step as it would inherently involve an operation on a particular machine.

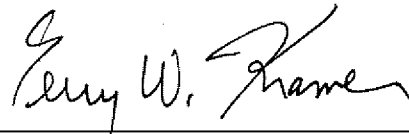
On page 31, the Examiner's Answer alleges that claim 25 recites "non-functional descriptive material" and is not "entitled to patentable weight." In response, Appellant respectfully submits that MPEP 2106.01 defines "non-functional descriptive material" as material such as music and literary works. In this case, claim 25 recites that a DRO (digital rights object) represents exactly one permission to use an associated DDO (digital data object). This relationship clearly involves the function of determining whether to grant permission to use a DDO.

CONCLUSION

For at least the reasons discussed above, Appellant respectfully submits that the rejections are in error and that claims 8-27 are in condition for allowance. Therefore, Appellant respectfully requests that this Honorable Board reverse the rejections of claims 8-27.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062.

Respectfully submitted,
KRAMER & AMADO, P.C.



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